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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,093	05/22/2000	Steven G. Henry	10002031.1	2499

22879 7590 03/31/2004

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EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

12

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,093

Applicant(s)

HENRY ET AL.

Examiner

DAVID Y. ENG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-24 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-24 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The active claims are 1, 4-24 and 30.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielson (USP 6,405,243) in view of Reilly (USP 6,427,164).

With respect to claims 1, 4, 5, 6, 8, 9, 11, 12, 14, 15, 16, 17, 19, 20, 21, 22, 24, see at least Figures 1-5 and the description thereof in Nielson. Nielson teaches in Figure 5 (column 7 lines 6-25) a method for processing sending information (see "forwarding an email message" in line 54 of column 1) in a sending device (101, Figure 1), comprising:

Receiving (see "BEGIN" in Figure 5) an entry (email message containing recipient's old email address, inherent from step 503) input by a user (sender of the email message) at the sending device (101, Figure 1), the entry comprising sending information that identifies a destination (recipient's old email address) to which information is to be sent by the sending device;

responsive to the entry, cross-referencing (see steps 501, 503 and 505 in Figure 5) the user-entered sending information with a contacts database (see Book File in step 501) that contains recipient sending information of the user to determine (step 505) if the user-entered sending information matches sending information saved in the contacts database;

providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information (see lines 61-66 of column 6 in Nielson); and

automatically caching the user-entered sending information in the contacts database (see step 507) if the user-entered sending information has not been previously saved.

Although Nielsen refers to the address book as the sender's address book in lines 10-14 of column 7, Nielsen does not explicitly state that the sender address book is stored in the sender's sending device. Reilly teaches a sender's address book which is stored in a sending device 110 (see lines 54-58 of column 9 in Reilly). From the teaching of Reilly, it would have been obvious to a person of ordinary skill in the art to store a sender's address book in a sending device such that the address book can be used by the sending machine.

With respect to claims 7, 13, 18 and 23 the sending device 101 of Nielson is also a digital sender capable of emailing (see abstract). Fax machine and fax machine in combination with other communication machine such as email machine are well known in the art. It would have been obvious to a person of ordinary skill in the art to incorporate fax capability in the sending device of Nielson such that it is less expensive to buy both machines.

With respect to claim 10, log in before a device can be used is well known in the art.

With respect to claim 30, determining an identity of the user is an inherent step in log in process.

In the communication filed on 2/2/2004, Applicants contended that the cross-referencing in Nielson does not occur responsive to the entry. The Examiner disagrees. Nielson's system is for forwarding email message (see the first sentence in abstract). In fact, all the procedures in Neilson are initiated when a user enters a sending message to be forwarded to a destination address. See the procedure in Figure 5 for example. The procedure in Figure 5 is initiated when a user enters sending information. Applicants further contended that Nielson does not teach responsive to the entry, cross-referencing (see steps 501, 503 and 505 in Figure 5) the user-entered sending information with a contacts database (see Book File in step 501) that contains recipient sending information of the user to determine (step 505) if the user-entered sending information matches sending information saved in the contacts database. The Examiner disagrees. See the rejection above. Nielson teaches exactly that in steps 505 and 507 in Figure 5. Applicants further contended that Nielson does not teach providing previously saved sending information to the user as a selection option if sending information entered by the user matches the previously saved sending information. The Examiner disagrees. Nielson clearly teaches that in lines 61-66 of column 6.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A handwritten signature in black ink, appearing to read 'David Y. Eng', with a stylized flourish at the end.

DAVID Y. ENG
PRIMARY EXAMINER